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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,365	10/26/2001	Steven B. Dawes	SP01-277	2877
22928 7590 02/15/2007 CORNING INCORPORATED SP-TI-3-1 CORNING, NY 14831				
			EXAMINER HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER
			1731	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/15/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/053,365	Applicant(s) DAWES ET AL.	
	Examiner John Hoffmann	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7-14,17-21,23,29-41,44,45,51-53,56 and 132-138 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,7-14,17-21,23,29-41,44,45,51-53,56 and 132-138 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 5 depends from claim 4. Claim 4 has been canceled, thus claim 5 does not depend from a previous claim. Claim 5 is not treated further on its merits

Double Patenting

Applicant is advised that should claim 1 be found allowable, claim 31 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 7-14, 17-21, 23, 29-41, 44-45, 51-53, 56 and 132-138 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The each of the independent claims (except for claim 132) uses at least either "holding" or "pulse". The terms "hold", "held" and "pulsing" are defined by applicant. See the specification page 11, lines 17-22 and page 12, lines 17-19. As indicated above, it is Office policy that applicant's definitions control claim interpretation. Each of Applicant's definitions are limited to "chamber 114". Thus it is deemed that the claims are not directed to applicant's chambers 214, 314 and 414. To examiner, these other chambers are substantially identical to chamber 114. Examiner notes that chambers are substantially the nothingness within a vessel. Thus one might conclude that applicant intended that the "114" constitutes the vessel (page 6, lines 24-25 of the specification supports this) – but the drawings show that the vessels are substantially the same. One of ordinary skill is not reasonably apprised as to what applicant means by "chamber 114" in the definitions. Moreover Applicant argues on page 22 of the 26 December 2006 responses that Applicant disagrees with the Office's indication that applicant's definitions require the use of chamber 114. Since it is applicant's position that the definitions in the specification are incorrect, one would be at a complete loss as to what the terms actually mean.

Claim 132 (and the other independent claims) refer to at least one other term defined in the present application (e.g. see specification, page 5, lines 26-30). Given that applicant is arguing that the definition for "hold" in the specification is not appropriate, it is deemed that this calls into question whether the other definitions in the specification are to be given any weight. It is deemed that one would not be able to determine what the metes and bounds of the terms are.

Art Unit: 1731

The dependent claims which refer to steps of pressurizing and the like are indefinite as to whether they require further pressurizing or if they merely limit previously mentioned pressurization. There is confusing antecedent basis for "pressurization" in claim 39.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-14, 17-21, 23, 29-41, 44-45, 51-53, 56 and 132-138 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishiguro, Yokoyama, Schneider, Hicks or Ishikawa.

See the prior Office action of 02 June 2004 for the manner in which the art is applied. As to the specific claim limitations: Applicant presently argues that the terms are not limited to the definitions set forth in the specification. For example the term "hold" requires chamber 114 as indicated on page 12 of the specification. Applicant points out that the specification indicates that the methods may be executed using other apparatuses described in the application. It is the Office's position that, using Applicant's reasoning, the claimed methods can be executed using other methods described in the specification. Thus, as set forth in the 02 June 2004, the inventions

Art Unit: 1731

(then claimed) are anticipated by the prior art. The present claimed methods are met because they encompass the same inventions.

To put it in other terms: Applicant has set forth the broadest reasonable interpretation of how to interpret the claims: they are directed to what is disclosed in the specification – and not limited to what the claims define. As set forth in the June 2004 rejection, there are inventions that are not novel. Since applicant has set forth the proper way to interpret the claims as: they encompass any of the disclosed methods/apparatuses – it has been established there is at least one non-novel invention described. Thus the claims are not limited to a non-novel invention.

The PTO gives a disputed claim term its broadest reasonable interpretation during patent prosecution. Hyatt, 211 F.3d at 1372. The “broadest reasonable interpretation” rule recognizes that “before a patent is granted the claims are readily amended as part of the examination process.” Burlington Indus. v. Quigg, 822 F.2d 1581, 1583 (Fed. Cir. 1987). Thus, a patent applicant has the opportunity and responsibility to remove any ambiguity in claim term meaning by amending the application. In re Prater, 415 F.2d 1393, 1404-05 (CCPA 1969). Additionally, the broadest reasonable interpretation rule “serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.” In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting In re Yamamoto, 740 F.2d 1569, 1571-72 (Fed. Cir. 1984)).

Furthermore it is noted that applicant makes no assertion in the present response in accordance with 37 CFR 1.111 that there is any patentable novelty or what such novelty is.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 7-14, 17-21, 23, 29-41, 44-45, 51-53, 56 and 132-138 rejected under 35 U.S.C. 103(a) as being unpatentable over Ikuta, Ishiguro, Yokoyama, Schneider,

Art Unit: 1731

Hicks or Ishikawa. See above as to why the broadest reasonable interpretation of the claims encompasses all of the disclosed inventions. See also the rejection of 4/12/2006 which points out how Ikuta reads on at least one disclosed embodiment.

Response to Arguments

Applicant's arguments filed 26 December 2006 have been fully considered but are moot in view of the new grounds of rejection.

Applicant argues that Applicant's definitions are not limited to chamber 114. The argument merely points to various portions of the specification and argues that one would understand that other chambers could be used in the methods. Examiner fails to see the connection between "methods" and those specific methods which requires steps of "holding" and/or "pulsing". As pointed out in MPEP 2173.05(a)

When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

Thus, applicant's position (that the claim terms do not have the meanings as set forth in the specification) is untenable. Especially given that applicant gives no explanation as to why the stated definitions should not be used or what the correct interpretation is. Merely pointing to other passages does constitute an argument. Examiner sees nothing in those other passages which suggests the definition is not as stated on page 12.

Art Unit: 1731

Applicant also states one of ordinary skill would understand what "chamber 114" is. However no explanation as to what it is offered. Nor is any argument given to support applicant's position. Applicant's suggestion that chamber 114 is also chambers 214 and 314 is deemed to be without merit. Concluding that one thing is the same as something else is not reasonable especially given that all 8 inventors have reviewed the disclosure and thus agreed that their invention is one in where "holding" is directed to chamber 114.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

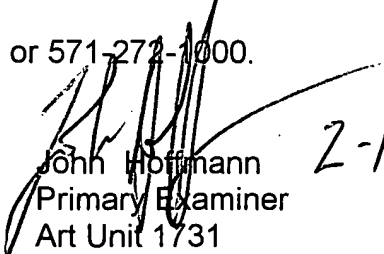
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1731

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John Hoffmann
Primary Examiner
Art Unit 1731

2-13-07

Jmh